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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/084,977 | 03/01/2002 | Peter Ott | 01024 | 2208 |

7590 06/12/2003
Walter Ottesen
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EXAMINER

FINEMAN, LEE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2872

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/084,977

Applicant(s)

OTT, PETER

Examiner

Lee Fineman

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claim 2-4 and 10-12 are objected to because of the following informalities: Claims 2 and 10 state "wherein the adjustment of said lamp unit takes place motor controlled by software" which is grammatically incorrect. The examiner suggests --takes place using a motor controlled by software--. The dependent claims inherit the deficiencies of the claims from which they depend.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al., U.S. Patent No. 6,179,448 B1.

Regarding claims 1-5, 9-14, Johnson et al. disclose a system and method for adjusting a lamp unit relative to an illuminating beam path of a microscope devoid of a beam homogenizer in said illuminating beam path (column 1, lines 49-53), said microscope (fig. 1) including a microscope objective (6) defining a pupil plane; an adjustable lamp unit (12) for supplying the light transmitted along said illuminating beam path (fig. 1); a detector (32) for detecting the light power of the light; motor drives (30) for adjusting said light unit relative to said illuminating

Art Unit: 2872

beam path; and an evaluation and control computer (34), that includes software, connected to said detector and functioning to sequentially drive said motor drives until a maximum of an integral light power is measured with said detector (fig. 1; column 4, lines 13-38), the method comprising the steps of measuring the integral light power downstream of said pupil plane of said objective with said detector; applying a gradient method for locating said maximum of said light power and adjusting said light unit relative to said illuminating beam path so that the light power detected by said detector is a maximum; and (column 2, lines 13-57). Johnson et al. disclose the claimed invention except for the detector receiving transmitted light. Official Notice is taken of the equivalency of use of transmission and reflective systems in microscopy. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the system of Johnson et al. a transmission system to examine different characteristics of the sample.

Regarding claims 15 and 16, Johnson et al. further disclose wherein said microscope defines an optical axis along said beam path (fig. 1); and said microscope further comprises a collector optic (78, fig. 6) mounted in said illuminating beam path downstream of said lamp unit; an additional motor drive (84) for displacing said collector optic along said optical axis; and wherein the evaluation and control computer further functions to apply the gradient method for locating said maximum of said light power by carrying out the following steps: beginning from a start position and determining the maximum gradient of the light power in dependence upon a position change of at least one of said lamp unit and said collector optic; and displacing at least one of said lamp unit and said collector optic in a direction of the maximum gradient of the integral light power (column 2, lines 30-57).

4. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Nishi, U.S. Patent No. 5,861,944.

Johnson et al. further disclose a specimen table (2). Johnson et al. disclose the claimed invention as set forth above except for the detector being integrated into said specimen table. Nishi teaches a system (fig. 1) for adjusting light intensity that includes a detector (58) integrated into the specimen table (57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the detector into the specimen table in the system of Johnson et al., as suggested by Nishi, to provide a compact system that will provide accurate intensity information very near the exposure point of the specimen.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Application/Control Number: 10/084,977

Page 5

Art Unit: 2872

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

LAF

LAF

June 3, 2003

Mark A. Robinson
MARK A. ROBINSON
PRIMARY EXAMINER